

REMARKS

Claims 1, 3-11, 13-21 and 23-33 are currently pending in the above-identified application, with claims 1, 11 and 21 being independent. In this Amendment, claims 1, 11 and 21 have been amended.

Claims 1 and 21 have been amended to clarify that the apparatus comprises a sample slot adapted to receive a sample tab to be placed within the light path. Claims 1, 11 and 21 have been amended to delete the expression "using a calibration set smaller than the primary calibration set and comprising samples distinct from those of the primary calibration set." These amendments find support in the written description as originally filed. No new matter has been introduced by these amendments.

This Amendment is supplemental to the Amendment submitted on December 1, 2008, which was filed in response to the September 30, 2008 Office Action. The amendments and remarks presented therein are incorporated herein by reference.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 1-33 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite with respect to the manner in which the one or more than one upgraded primary calibration algorithm is produced. This rejection has been rendered moot by the presently-amended claims.

Reconsideration and removal of this rejection is respectfully requested in view of the amendments set forth above.

Claim Rejections under 35 U.S.C. § 103

Claims 1-33 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,846,492 in view of U.S. Patent No. 5,459,677, Wehlburg, Greensil, Ozdemir, Sum, Despagne or Swierenga. Applicant has addressed these rejections by way of the foregoing amendments and the remarks set forth below.

The cited references do not teach or suggest either individually or in combination the presently-claimed spectroscopic apparatus, which includes a sample slot adapted to

receive a sample tab, and one or more than one upgraded primary calibration algorithm for one or more than one analyte, the one or more than one upgraded primary calibration algorithm in operative association with the spectroscopic apparatus and developed on the spectroscopic apparatus by combining some, or all of a calibration data set derived from a primary calibration set and obtained from one, or more than one other apparatus with additional data obtained from the spectroscopic apparatus.

To support an obviousness rejection, MPEP §2143.03 requires “all words of a claim to be considered” and MPEP § 2141.02 requires consideration of the “[claimed] invention and prior art as a whole.” Further, the Board of Patent Appeal and Interferences recently confirmed that a proper, post-KSR obviousness determination still requires the Office make “a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.” *In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) and *CFMT v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003).

Consequently, it remains well-settled law that an obviousness rejection requires at least a suggestion of all of the claim elements. As the former obviousness rejection ignores the feature of the sample slot being adapted to receive a sample tab, the obviousness rejection in respect of claims 1, 11, and 21 is improper.

Accordingly, the presently-claimed apparatus is inventive in view of the cited references.

Applicant respectfully requests that that the rejections under 35 U.S.C. § 103(a) be withdrawn in view of the foregoing amendments and comments.

CONCLUSION

Applicant submits that the above-identified application is now in a condition for allowance, and favorable reconsideration and prompt allowance of these claims are respectfully requested. Should the Examiner believe that anything further is desirable in order to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at 202-775-5771.

In the event this paper is not considered to be timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account No. 01-2300, **referencing docket number 026806-00014**.

Respectfully submitted,
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